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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05-CV-1114 JW **SATELLITE DEFENDANTS' MEMORANDUM RE THE DEFINITIONS OF TERMS IN CLAIMS 41-45 OF THE '992 PATENT** Date: June 2, 2006 Time: 9:00 a.m. Courtroom: 8, 4th Floor Judge: Hon. James Ware

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INTRODUCTION

The current round of *Markman* briefing is limited to the terms of the '992 and '275 patents. Acacia accuses EchoStar and DIRECTV (the "Satellite Defendants") only of infringing Claims 41-45 of the '992 patent. The '275 patent is not asserted against the Satellite Defendants. The Satellite Defendants therefore jointly submit this claim construction brief, which covers the remaining disputed terms in Claims 41-45 of the '992 patent.

ARGUMENT

Claims 41-45 of the '992 patent present six issues for consideration. *First*, the preamble of Claim 41 should be construed to be a limitation requiring that all of the recited steps be performed by a "transmission system." *Second*, all of the steps of Claim 41 must be performed in the recited order and prior steps be completed before subsequent steps begin. *Third*, Claim 41 refers to sending information to "one of the remote locations." The claim language, specification, and plain meaning of the word "one" make it clear that this phrase should be construed to mean "one *and only one* of the remote locations." *Fourth*, the term "items," as used in the phrase "items having information," should be construed to mean "physical objects on which information is stored." *Fifth*, the term "addressable," as used in the phrase "sequence of addressable data blocks," should be construed to mean that "that there is a known association between each data block and its storage location so that the transmission system can retrieve any individual data block by using its storage location." *Sixth*, dependent Claim 45 is insolubly ambiguous and is therefore indefinite.

I. CLAIM 41'S PREAMBLE IS LIMITING AND REQUIRES THE CLAIM'S STEPS TO BE PERFORMED BY A TRANSMISSION SYSTEM.

A preamble is limiting if it recites structure that is important to the invention, is necessary to give meaning to the claim, or is relied on by the applicant during prosecution. *See, e.g., Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1370 (Fed. Cir. 2003). Here, the preamble was amended during prosecution to obtain allowance of Claim 41. The law is clear that reliance on the preamble to gain allowance of a claim "transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed limitation." *Invitrogen*, 327 F.3d at 1370 (quoting *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09 (Fed. Cir. 2002)). The preamble also recites that the "transmission system" performs all the operative steps of the claim. For this reason as well, the preamble is a limitation of the claim. *See Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (holding that a preamble was limiting where claim steps were performed by the structure described in the preamble). Thus, the preamble of Claim 41 is limiting and requires that the *transmission system* perform the steps of the claim.

A. The Phrase "Performed by a Transmission System" was Added to the Preamble of Claim 41 to Gain Allowance.

During prosecution, applicants added Claim 41 by an amendment filed on September 30, 1991. *See* Declaration of David M. Hymas In Support of Satellite Defendants' Memorandum Re the Definitions of Terms in Claims 41-45 of the '992 Patent ("Hymas Decl."), Ex. A. As originally written, the preamble did not specify any structure for performing the steps recited in the body of the claim:

> 41. A method of transmitting information to remote locations, the transmission method comprising the steps of:

Id. at 11.

On December 10, 1991, the PTO rejected every pending claim. Claim 41 was rejected over *Abraham '806* in view of *Ulicki '733*. Hymas Decl., Ex. B at 2-3. Following this rejection, the Applicants held an interview with the Examiner on December 20, 1991. Hymas Decl., Ex. C. Applicants then filed an amendment on December 26, 1991. In the amendment, Applicants made only one change to Claim 41 — they added to the preamble the following phrase: "performed by a transmission system." The preamble of amended Claim 41 is below, with the added portion in bold:

> 41. (Amended) A method of transmitting information to remote locations, the transmission method comprising the steps, *performed by a transmission system,* of:

Hymas Decl., Ex. D at 5.

Applicants urged that "the independent Claims 1, 18, 22, 41, 47 and 54, as well as the claims which depend directly or indirectly from these claims, are novel and nonobvious." *Id.* at 11. In other words, the sole ground for rejection of Claim 41, obviousness, was overcome by this amendment to the preamble. On February 5, 1992, without further change to Claim 41, the Examiner issued a Notice of Allowability. Hymas Decl., Ex. E.

As the prosecution history demonstrates, the phrase "performed by a transmission system" was added to Claim 41 to gain allowance of an otherwise rejected claim. Reliance on the preamble to overcome a prior art rejection means that the preamble is a claim limitation. *See Invitrogen*, 327 F.3d at 1370 (phrase added during prosecution treated as a limitation); *Strattec Security Corp. v. General Auto. Specialty Co.*, 126 F.3d 1411, 1418 (Fed. Cir. 1997) (same); *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003) (same).

Acacia cannot now — thirteen years after the preamble was amended for purposes of patentability — seek a construction that effectively removes the very limitation that was added to gain allowance of the claim. The phrase "performed by a transmission system" is material and, together with the body of the claim, defines the subject matter of Claim 41. For this reason alone, the preamble of Claim 41 should be treated as a limitation.

B. The Preamble Limits Claim 41 Because the "Transmission System" is the Structure That Performs the Steps of the Claim and Because the "Transmission System" was Represented to be Significant in the Petition to Make Special.

The preamble of Claim 41 requires that the "transmission system" perform the steps of the claim.[1] The Federal Circuit has held that when the structure that performs method steps is described *only* by the preamble, it is an example of "the claim drafter choosing to use both the preamble and the body to define the subject matter of the claimed invention." *Eaton*, 323 F.3d at 1340 (internal citation omitted). In such circumstances, the preamble is a limitation. *Id.* Here, it is self-evident that both the preamble and the body define the claim: the preamble specifies the transmission system as the structure for performing all the steps of Claim 41. "[A] claim preamble has the import that the claim as a whole suggests for it." *Id.* at 1339 (quoting *Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)). Because the preamble is the structure that performs the claim's steps, the claim as a whole demonstrates that the preamble is limiting.

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[1] This Court has already construed the term "transmission system" to mean, "an assembly of elements, hardware and software, that function together to convert items of information for storage in a computer compatible form and subsequent transmission to a reception system." July 12, 2004 *Markman* Order ("*Markman* I") at 28 (attached as Ex. F to the Hymas Decl.).

That the preamble serves to define Claim 41 is supported by the patentees' own view of their invention, as expressed in their June 17, 1991, Petition to Make Special ("PTMS").[2] Hymas Decl., Ex. G. A PTMS allows applicants to advance their filings to the front of the filing line upon a showing that they have conducted a pre-examination art search, submitted a copy of closely related prior art references, and pointed out "how the claimed subject matter is distinguishable over the references." Manual of Patent Examining Procedure, § 708.02 VIII (8th ed. 2001). Statements in a PTMS can be particularly persuasive evidence regarding the meaning of claim terms since those statements are the applicants' view of their invention in light of the prior art. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1477 (Fed. Cir. 1998) (holding that PTMS gave meaning to term "console," irrespective of the term's ordinary meaning); *see also Mark I Mktg. Corp. v. R.R. Donnelley & Sons Co.*, 66 F.3d 285, 291-92 (Fed. Cir. 1995) (relying on PTMS to narrow construction of claims).

The PTMS included a detailed description of 37 prior art references. The applicants distinguished 16 of these references by pointing out that they did not disclose a "transmission system." Hymas Decl., Ex. G at 6, 11-12, 16, 18-23. In other words, the applicants argued that their transmission system (and its attendant functions) distinguished the claimed invention from many of the prior art references in the PTMS. For example, the applicants distinguished the Lang reference by arguing that Lang "does not teach or suggest a *transmission system for providing information to remote locations* which includes library means for storing items." *Id.* at 6

[2] The PTMS was filed before the Claim 41 amendment adding the phrase, "performed by the transmission system." The Applicants, therefore, recognized the importance of the "transmission system" to their claimed invention from early on in the prosecution.

(emphasis added). This statement and the other similar explanations in the PTMS further indicate that the preamble is limiting because the applicants defined their invention by reference to the transmission system's functionality. The asserted novelty of the claimed invention rested on the functions that the *transmission system* performed — functions that included sending information to one of the remote locations as described by the steps of Claim 41.

C. Acacia's Misapplication of Federal Circuit Precedent is Unconvincing.

Acacia relies on *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340 (Fed. Cir. 1998), and *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870 (Fed. Cir. 1991), to argue that the preamble is not limiting. Acacia's reliance on these cases is misplaced.

In *Vaupel*, the claim covered a method for forming a plurality of patterned strips using a broad weaving machine including a "breast beam." The court found that the "breast beam" was a reference point to fix the direction of movement of the woven fabric. *Vaupel,* 944 F.2d at 879-80. Although Acacia relies on *Vaupel* to argue that the preamble of Claim 41 should not be a limitation, the Federal Circuit confirmed in a subsequent case that the term "breast beam" *was* a limitation in *Vaupel*:

> [In *Vaupel* w]e did not conclude, . . . , that the term "breast beam" could be ignored because it appeared in the preamble; in fact, the analysis in *Vaupel* has nothing to do with the issue of whether the preamble was necessary to define a complete invention. Rather, the issue was the proper meaning of the term "breast beam." We agreed with the district court that the term "breast beam" meant "a reference point to fix the direction of movement of the woven fabric from the loom" and that this meaning should be applied in the infringement analysis. Thus, while we concluded that the term "breast beam" was not a structural limitation of the claims; *it was nevertheless a limitation.*

Eaton, 323 F.3d at 1341 (emphasis added). Thus, *Vaupel* undermines Acacia's position.

Moreover, the preamble of Claim 41 presents a clearer case of treating the preamble as a limitation than the preamble of *Vaupel.* As explained in the discussion of *Vaupel,* the court in *Eaton* said, "[t]he method claim in *Vaupel* [did] not require that any step of the claimed method be performed by the breast beam." *Id*. In contrast, Claim 41's preamble clearly indicates that the transmission system performs *all* of the steps. *See id*. (distinguishing *Vaupel* on ground that the claim in *Eaton* required "the manipulation and operation of structure that is identified and described by the preamble").

C.R. Bard also has no application to this case. In *C.R. Bard* the claim at issue was directed to a "biopsy needle." 157 F.3d at 1348. The preamble read:

> A biopsy needle *for use with* a tissue sampling device having a housing with a forward end, a first slide mounted for longitudinal motion within said housing, and a second slide mounted for longitudinal motion within said housing, said biopsy needle comprising:

Id. at 1348-49 (emphasis added). The court found that the preamble was not limiting because it served only to provide a reference point for the claimed needle. As the *Eaton* court explained,[3] the preamble in *C.R. Bard* was "an example of a statement of *intended use* of the claimed invention: the plain language of the preamble states that the biopsy needle is 'for use with' the structure described by the remainder of the preamble." *Eaton,* 323 F.3d at 1341 (emphasis added). Because the plain language of the claim did not require the biopsy needle to couple with the tissue sampling device (the structure disclosed in the preamble), the preamble of *C.R. Bard* was not a limitation. *Id.* at 1342. Here, the preamble of Claim 41 does much more than state an *intended* use of the invention — the "transmission system" is recited to be the structure that actually performs the steps of the claim. Therefore, the reasoning of *C.R. Bard* does not apply here.

For all of these reasons, the preamble of Claim 41 is limiting and requires that the steps of the claim be performed by the transmission system.

II. THE STEPS OF CLAIM 41 MUST BE PERFORMED IN SEQUENTIAL ORDER.

It is well-established that the steps of a method patent must be performed in sequential order either when the steps recite an order or when, as here, "the method steps implicitly require that they be performed in the order written." *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (quoting *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342-

[3] Interestingly, in *Eaton*, the plaintiff relied on *C.R. Bard* and *Vaupel* to make the same arguments Acacia makes here. The Federal Circuit rejected those arguments and this Court should do the same.

43 (Fed. Cir. 2001)). For claims that do not explicitly recite a specific order, courts look first at whether "as a matter of logic or grammar, [the steps] must be performed in the order written." *Altiris*, 318 F.3d at 1369.

Claim language logically suggests that steps must be performed sequentially when subsequent steps indicate that prior steps have already been performed. *See Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1375-76 (Fed. Cir. 1998); *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1321-22 (Fed. Cir. 1999) (finding that steps in claim had to be performed sequentially). The language of Claim 41 plainly meets this requirement.

A. The Steps of Claim 41 Must be Performed in Order and After Any Prior Steps are Completed.

Here, logic, grammar, and consistency with the specification require that Claim 41's steps to be performed in the listed order and that any prior steps be completed before subsequent steps begin. Claim 41 recites the following steps:

> A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:
>
> [1] storing items having information in a source material library;
>
> [2] retrieving the information in the items from the source material library;
>
> [3] assigning a unique identification code to the retrieved information;
>
> [4] placing the retrieved information into a predetermined format as formatted data;
>
> [5] placing the formatted data into a sequence of addressable data blocks;
>
> [6] compressing the formatted and sequenced data blocks;
>
> [7] storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
>
> [8] sending at least a portion of the file to one of the remote locations.

'992 patent, 24:54-25:5.

As a matter of simple grammar and logic, the claim's language dictates that the steps must take place sequentially and only after any prior step has been completed. Step 1, the "storing" of "items having information in a source material library," must logically precede and be completed prior to the beginning of step 2, "retrieving" the information from the source material library. Without having previously stored items in the "source material library," there would be nothing in the library to retrieve. Similarly, step 2, the "retrieving" step, must be completed and must precede steps 3 and 4, both of which refer to "retrieved information" in the past tense. Step 3 assigns a "unique identification code to the retrieved information." Without "retrieved information" there would be nothing that could be assigned an identification code. Likewise, step 4 requires that there be "retrieved information" prior to placing that information into a "predetermined format as formatted data."

The formatting step, step 4, must then be completed prior to steps 5, 6, and 7, all of which refer to "formatted" data, again in the past tense. Absent step 4, there would be no "formatted data" to place into a "sequence of addressable data blocks" in step 5. In the same way, without "formatted data," step 6 could not compress "the *formatted* . . . data blocks," and step 7 could not store "as a file, the . . . *formatted* . . . data blocks."

Steps 5 and 6 must occur next. The sequencing step, step 5, must be completed prior to proceeding with steps 6 and 7, both of which refer to "sequenced data blocks" in the past tense. Step 6 could not compress the "sequenced data blocks" if the blocks had not already in fact been sequenced. Nor could step 7 store "sequenced data blocks" prior to step 5's sequencing of the data blocks. The compressing step, step 6, as well as steps 3, 4, and 5, must also be completed and must precede step 7, which can only store data blocks that have been "compressed," "formatted," "sequenced," and "assigned [a] unique identification code."

And finally, the claim language requires step 7, which involves the creation of "a file" for storage, to be completed and to precede step 8, in which "at least a portion of the file" is sent to one remote location. The file created in step 7 consists of "compressed, formatted, and sequenced data blocks with the assigned unique identification code." Logically, such a file can only be created after the steps that compress, format, sequence, and assign an unique identification code to the information have occurred and been completed. Only after the file is created can Step 8 send a portion of that file to one of the remote locations.

As in *Mantech*, the language of Claim 41 is clear and nothing in the specification suggests otherwise. Indeed, the specification is consistent with the claim's language in requiring the steps to proceed in sequential order and to be completed prior to subsequent steps beginning. For example, the preferred method of distribution by the transmission system, both as described in the specification and Figure 7, discloses the following sequence (with the bracketed numbers referring to the steps recited in Claim 41):

> [1] a source material library means, '992 patent, 18:53-56;
>
> [2] "retrieving the information for selected items [stored] in the source material library," *id*. at 18:53-55;
>
> [3] "*[a]fter* the information for the selected items is retrieved," the distribution method assigns "a unique identification code to the retrieved information," *id*. at 18:60-66;
>
> [4] "placing the retrieved information into a predetermined format as formatted data, *id*. at 18:68-19:2;
>
> [5] "placing the formatted data into a sequence of addressable data blocks," *id*. at 19:2-4;
>
> [6] "compressing the formatted and sequenced data, *id*. at 19:5-7; and
>
> [7] "storing as a file the compressed sequenced data . . . with the unique identification," *id*. at 19:7-9.

As set forth in Claim 41, the specification explains that a source material library must exist at step 1 before information can be retrieved in step 2. Steps 3 and 4 clearly must occur after step 2 has been completed since the specification uses the term "after," and the steps themselves reference the information retrieved from the source material library during step 2. Step 5 must logically occur after step 4 since it would otherwise be impossible to place "formatted data" into "a sequence of addressable data blocks" unless the data was already formatted. In the same way, step 6 must occur after steps 4 and 5 have been completed because it would otherwise be impossible to compress "formatted and sequenced data" without the data having already been formatted and sequenced. And finally, step 7 stores the data, which has been completely processed during the preceding steps, as a file.

Other passages in the specification confirm the sequence of Claim 41 and the fact that its steps must be completed in order as recited. The summary of the invention discloses the same order. *Id*. at 2:26-48. Figure 2a, which is a preferred embodiment of the transmission system, and its accompanying description in the specification also set forth the same sequential order. For example, the specification first describes a source material library into which different types of information, such as television programs, movies, or audio recordings, are deposited. *Id*. at 6:8-34. Consistent with the claim, the specification discloses that Step 4's formatting element occurs "*after*" step 3's identification encoding. *Id*. at 6:58-62. Obviously, the information must be retrieved, as described by step 2, before either steps 3 or 4 can occur. Step 5's sequencing step then occurs "*[a]fter* the retrieved information is converted and formatted." *Id*. at 7:64-68. After the data is sequenced, it is prepared for compression and compressed, as outlined by step 6. *Id*. at 8:59-62; 9:40-42. And, "*after* compression processing," the data is placed into a single file and stored. *Id*. at 10:23-26 & 36-39.

Any argument that the steps of Claim 41 may be performed simultaneously or out of the recited order ignores the basic principle of patent law that "[t]he specification must teach and enable all the claims." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1325 (Fed. Cir. 2005). "[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). Here, the specification not only fails to discuss alternate sequences, it fails to teach that some steps could occur at the same time as other steps. For example, the specification does not teach that formatted data is "partially formatted" before proceeding to subsequent steps nor does it teach that data blocks can be compressed and sequenced at the same time. The specification's failure to even mention that the steps could be performed concurrently is insufficient to teach an individual skilled in the art "how to make and use the full scope of the claimed invention." Instead, consistent with the claim language and as outlined above, the specification teaches that subsequent steps occur only after preceding steps have been completed.

B. Acacia's Attempt to Blur the Sequence of the Claim is Unsupported.

Acacia's arguments against the language of the claim are unpersuasive. Acacia purports to agree that the steps of Claim 41 proceed in sequential order. However, it also tries to argue that there is no requirement that any step "begins and occurs only after a prior step or steps have been completed," stating in conclusory fashion — and without citations to the patent or case law — that Claim 41 includes no such limitation. *See* Acacia's April 17, 2006, *Markman* Brief at 52-53, 58. These positions are inconsistent. If steps could be performed before, during, or after other steps, by definition the claims would not recite a sequential order. Acacia's argument ignores the plain language of the claim and specification, as detailed above.

Further, the Federal Circuit has rejected Acacia's argument in similar cases. For example, in *Combined Systems, Inc. v. Defense Technology Corp. of America*, 350 F.3d 1207 (Fed. Cir. 2003), the Federal Circuit had to construe a method claim for non-lethal projectiles, such as those used in police work. At issue was claim language outlining steps that (1) formed "folds" in a projectile body and (2) inserted the "formed folds" of the projectile body into an empty shotgun shell. *Id*. at 1208-09. The district court required that the folds be formed prior to, and not during, insertion into the shotgun shell. *Id*. at 1211. Like Acacia, the patentee argued that the steps could occur concurrently. The Federal Circuit disagreed and affirmed the district court, finding that:

> plainly *as a matter of grammar*, the recitation of "inserting said formed folds . . . into said projectile compartment" forecloses — at least in the absence of compelling evidence to the contrary in the written description or prosecution history — a construction permitting the "folds" to be formed after or during insertion of the projectile into the projectile compartment in the shotgun shell.

Id. at 1211-12 (emphasis added). In other words, according to the plain meaning of the claim terms, the subsequent step could only begin once the prior step had been completed.

In *Mantech* the Federal Circuit applied a similar analysis. *Mantech* involved a method patent for remediating contaminated underground water. The patentee argued on appeal that the steps could be performed simultaneously rather than in the order recited. 152 F.3d at 1370. The Federal Circuit disagreed, finding that before acetic acid could be injected into a well, as described by step 2 of the claim, the well had to first exist, as described by step 1. *Id*. at 1375-76.

Likewise, before a "solution of ferrous ion" could be mixed with "said acidified groundwater," "the acid must have already mixed with the groundwater to form acidified groundwater," as described by prior steps. *Id*. at 1376.

Like *Combined Systems* and *Mantech*, Claim 41 only makes sense, grammatically and logically, when it is read to require preceding steps be completed before the next step begins. Each step refers specifically and in the past tense to the preceding step or steps. A prerequisite to accomplishing each claimed step is the completion of the elements in the preceding step or steps. All the steps must be completed to send "at least a portion of the file to one of the remote locations." In short, and as the Federal Circuit held in *Mantech*, "the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise." *Id*. at 1376.[4]

III. THE PHRASE "ONE OF THE REMOTE LOCATIONS" IN CLAIM 41 SHOULD BE CONSTRUED TO MEAN "ONE AND ONLY ONE OF THE REMOTE LOCATIONS."

A key limitation in Claim 41 of the '992 patent is the requirement that the transmission system send at least a portion of the file "to one of the remote locations." As the Federal Circuit and district courts have found in construing similar claims, the ordinary meaning of such a phrase is "one and only one" of the remote locations. This definition is confirmed by the specification, by its usage in other claims in the '992 patent, and by the prosecution history of a related patent.

A. The Ordinary Meaning of "One" Requires Construing "One of the Remote Locations" to Refer to a Single Remote Location.

When the ordinary meaning of a disputed term is apparent, "claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *Phillips*, 415 F.3d at 1314; *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (claims given ordinary and customary meaning unless otherwise indicated in the specification). In this case, the ordinary and customary meaning of

[4] For similar reasons, claims 42-45 must be performed as part of the steps of claim 41 in which they are "include[ed]," and not "before, after or simultaneously with" the steps of claim 41, as Acacia argues. *See* Acacia's April 17, 2006, *Markman* Brief at 58-62.

"one" confirms that "one of the remote locations" means "one *and only one* remote location." Simply stated, one means one, not "one or more."

When used as an adjective or noun, the term "one" is defined by the *Webster's Third New International Dictionary* to mean "a single unit or entire being or thing *and no more*."[5] Hymas Decl., Ex. H at 1575. One of the explanatory examples is illustrative: "there is one apple in the basket." Thus, if there are three apples in a basket, one would not say that there is "one apple" in the basket. A second definition used by *Webster's Third New International* is also instructive: "being a particular unit or entire being or thing singled out (as by way of contrast, difference) from two or more identical or similar units or beings or things." *Id*. It provides the following examples: "spent one day of our vacation exploring the forest;" "have mentioned one important point out of the several that will have to be considered;" and "went from one side to the other." *Id*. In each of these examples, the term "one" is used to single out a particular. As in these examples, the "one" modifying "remote locations" serves to single out a particular location from other "remote locations" to which information is transmitted.

The Federal Circuit has confirmed that this dictionary definition is the ordinary meaning of "one" used in patent claims. In *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999), a claim was directed to a slot machine "comprising" several elements, including a "means for assigning a plurality of numbers" and a "means for randomly selecting *one of said plurality of assigned numbers*." *Id*. at 1346-47 (emphasis added). The party accused of infringing the patent argued that the phrase "one of said plurality of assigned numbers" was limited to selecting single numbers rather than combinations of numbers. *Id*. at 1349-50. The district court disagreed, ruling that there was nothing in the claim that limited generated numbers to a single number. *Id*. at 1349-50. The Federal Circuit reversed. It held that "[t]he plain meaning of 'selecting one of said … numbers' is selecting a single number, not a

[5] Other dictionaries provide similar definitions. *See, e.g., The American Heritage Dictionary of the English Language*, at 1228-29 (4th ed. 2000) (defining "one" to mean "being a single entity, unit, [or] object") (attached as Ex. I to the Hymas Decl.); *Merriam Webster's Collegiate Dictionary*, at 811-12 (10th ed. 1998) (defining "one" to mean "being a single unit or thing") (attached as Ex. J to the Hymas Decl.).

combination of numbers." *Id.* at 1350. Because nothing in the written description, drawings, or prosecution history indicated a contrary definition, the court held that the disputed term referred to a single number rather than combinations of numbers.

Tulip Computers Internationali B.V. v. Dell Computer Corp., 236 F. Supp. 2d 364 (D. Del. 2002), also confirms this interpretation. At issue in *Tulip Computers* was a patent claim directed to an "assembly for use in a personal computer." *Id.* at 368. The claimed assembly "comprised" several elements, including a "riser card." *Id.* at 368-69. The parties disputed the claim phrase "[w]herein a predefined *one of the positions* on the riser card has both ISA type and PCI type expansion connectors . . . ." *Id.* at 396 (emphasis added). There, as here, the patentee argued that the term "one," as used in the phrase "one of the positions," meant "one or more." The patentee further argued, as Acacia does here, that the claim's "use of the transitional phrase[] 'comprising' . . . does not exclude additional elements." *Id.* The court rejected the patentee's construction of the term "one," explaining:

> Dell's proposed construction, that 'a predefined one' combi-connector position means 'one *and only one*' combi-connector position, is not improperly imposing an unstated limitation on the claims at issue. *Dell's proposed construction merely applies the ordinary and accustomed meaning to the phrase. One means a single unit. One means one*.

Id. at 397-98 (emphasis added).

The analyses of *WMS Gaming* and *Tulip Computers* apply with equal force here. As in *WMS Gaming*, *Tulip Computers*, and the dictionary definitions, the "one" in Claim 41 refers to a single unit: one and only one.

B. Acacia Offers No Persuasive Reason to Deviate from the Ordinary Meaning of "One."

Acacia ignores entirely the meaning of the term "one." Instead, Acacia rewrites the claim, attempts to construe that rewritten claim, and then cites case law relating to the rewritten claim. *See* Acacia's April 17, 2006, *Markman* Brief at 53-56. In particular, Acacia asserts without any support that "[t]he term 'one' is used in this portion of the claim in the same manner that the term 'a' would be used, and therefore the term should be construed to mean 'one or more.'" *Id.* at 54.

Acacia goes on to rely on cases that interpret patent claims that include the term "a" or "an" rather than the term "one." *Id.* at 54-56. Indeed, Acacia fails to cite *any* cases that actually construe "one." Of course, the case law Acacia does cite is entirely irrelevant to the actual claim language. *See Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) ("[I]n accord with our settled practice we construe the claim as written, not as the patentees wish they had written it.").

Acacia's proposed construction of "one" additionally ignores the fact that the article "a" is used to modify numerous other terms in Claim 41. Indeed, immediately preceding the term "one," the patentees use "a" to modify "portion of the file." A simple cannon of claim construction dictates that "the use of both terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each." *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004); *see also Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004) ("[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms."). Thus, "one" *cannot* mean the same thing as "a." Acacia's approach turns Federal Circuit case law on its head by assigning the *same* meaning — rather than a different one — to different terms.

The mistake in Acacia's approach is particularly glaring because it uses *Webster's Third New International Dictionary* — the *same* dictionary that the Satellite Defendants use to define "one" — to define other terms in the '992 and '275 patents. *See* Decl. of Alan Block, Exs. 1-3, 5-6. Given the definition of "one," Acacia's failure to provide a dictionary definition of the term that actually appears in this claim is understandable.

C. The Specification Confirms the Ordinary Meaning of "One of the Remote Locations."

Nothing in the specification supports a contrary meaning of the phrase "one of the remote locations." Acacia points to "a number of embodiments in which the file or portion of the file is sent to at least one remote location." Acacia's April 17, 2006, *Markman* Brief at 54. Acacia ignores, however, several embodiments which are explicitly limited to sending files or portions of files to *one and only one* of the remote locations. Thus, the specification is fully consistent with construing Claim 41 to be limited, like many of the disclosed embodiments, to sending a file to only one location.

1. The Specification Discloses Numerous Embodiments that Describe Singular, Rather Than Plural, Remote Locations.

The specification discloses numerous embodiments — both those that require user input and those that do not — that refer to particular, distinct remote locations. For example, Figure 1a discloses a transmission system connected to a single reception system. In addition, the patentees' "Summary of the Invention" describes the invention as a "transmission and receiving system for providing information to remote locations." '992 patent, 2:28-29. The final element of the embodiment in the summary of the invention is a "transmitter means, coupled to the compressed data storing means, for sending at least a portion of a specific file to a *specific one of the remote locations*." *Id.* at 2:46-48 (emphasis added). This embodiment is consistent with the Satellite Defendants' proposed construction.

Similarly, at least two of the embodiments described in the specification describe transmitting to a specific, particular remote location. For example, Figure 7 describes "a preferred method of distribution." Steps 416 and 417 of Figure 7 limit the method to sending and receiving data at a singular "remote location." In further describing Figure 7, the specification refers to singular, rather than multiple, remote locations. It discloses a preferred embodiment that, as part of step 417, converts compressed formatted data "for output *to a reception system 200, selected by the user* . . . The requested information is then payed [*sic*] back *to the reception system 200 of the user* at the time requested by the user (step 419)." *Id.* at 19:23-36 (emphasis added). This description discloses a method whereby the user selects information for transmission. That information is eventually transmitted to the user's reception system at the remote location selected by the user, an interpretation consistent with the singular construction of remote location.

Thus, the Satellite Defendants' proposed construction is fully consistent with several embodiments described in the specification.

2. The Specification Does Not Provide a Special Meaning for the Term "One."

"[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess." *Phillips*, 415 F.3d at 1316. "If a divergent specialized usage were intended, the context was such that it was required to be clearly explained in the patent documents." *Kustom Signals, Inc. v. Applied Concepts, Inc.*, 264 F.3d 1326, 1331 (Fed. Cir. 2001). Here, the specification does not "reveal a special definition" for the term "one." Thus, the specification provides no basis to depart from the plain and ordinary meaning of the term "one of the remote locations."

D. Language from Other Claims Confirms the Meaning of "One of the Remote Locations."

The patentees knew how to claim multiple elements and did so when appropriate. Claims 6, 21, 45, and 47 of the '992 patent all include the modifier "plurality" to distinguish singular from plural elements. The term plurality means "comprising, or consisting of more than one." *Bowers v. Baystate Techs., Inc.*, 320 F.3d 1317, 1332 (Fed. Cir. 2003) (quoting *The Oxford English Dictionary* (2d ed. 1989)). Also illustrative is the use of the modifier "at least." For example, Claims 6, 22, 25, and 54 use the phrase "at least one" to describe various elements. Indeed, Claim 41 uses the modifier "at least a portion" immediately preceding the phrase "one of the remote locations." Claims 1, 19, and 47 also use this modifier to describe various plural elements. "Use of the phrase 'at least one' means that there could be only one or more than one." *Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999).

In sharp contrast to such language as "at least" and "plurality," the final clause of Claim 41 refers to "one of the remote locations." When a patent uses both singular and plural language in different claim elements, that difference should not lightly be disregarded. *See, e.g.*, *Interactive Gift*, 256 F.3d at 1334 ("Although the single element of Claim 37 initially mentions material objects in the plural, it is later modified by a singular reference and does not require more than one material object."); *Tulip Computers*, 236 F. Supp. 2d at 397-98 (comparing use of the modifier "at least" to give effect to singular term "one"). As in *Tulip Computers*, when the patentees wanted to describe plural elements in the '992 patent's claims, they used words to that effect.[6] This point is particularly compelling given the patentees' use of the term "one," rather than other obvious references to multiple elements, in the phrase "one of the remote locations." "It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement." *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1122 (Fed. Cir. 1985).

Like Claim 41, Claims 1, 19, and 47, also use the plural "remote locations" in their preambles to describe a plurality of sites. And like Claim 41, each of these claims also uses the phrase "one of the remote locations" in the claim language. This use distinguishes the singular phrase "one of the remote locations" from the plural phrase "remote locations" in the preambles. *See Interactive Gift*, 256 F.3d at 1334 (distinguishing "generality" of preambles' references to multiple elements from claims' more specific, singular references to the same elements). Acacia's argument that the preamble's reference to "remote locations" gives meaning to the singular "one of the remote locations" fails to account for the actual language of the claim and is flatly contrary to the Federal Circuit's instruction in *Interactive Gift*.

E. The Prosecution History of the '863 Patent Confirms that the Phrase "One of the Remote Locations" Points to a Single, Particular Remote Location.

The prosecution history of the '863 patent confirms the Satellite Defendants' proposed construction. The '863 patent is related to the '992 and '275 patents. Specifically, the application that issued as the '863 patent was a continuation of the application that issued as the '275 patent, which was in turn a continuation of the application that issued as the '992 patent. All three patents share the same specification. During the prosecution of the application leading to the '863 patent, and in response to a prior art rejection by the PTO, the patentees distinguished their claims for providing information to "remote locations" by explaining that they taught a system that provided information to "one of a plurality of remote locations," *i.e.*, "a *single* remote location."

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[6] Indeed, Claim 10 of the '863 patent, which is from the same patent family tree as the '992 and '275 patents and which also uses the same specification, claims a transmitter means for transmitting a file "to *at least one of a plurality* of the remote locations" in obvious contrast to the singular "one" used in Claim 41. Hymas Decl., Ex. K at 21:16-17.

Included with a May 13, 1994, Amendment to the '863 application were new Claims 21 and 22 (eventually renumbered 33 and 34), which disclosed a "transmission system for providing information to be transmitted to remote locations." Hymas Decl., Ex. L at 1-2. Claim 33 included a "transmitter means," which, coupled to the conversion means, provided "for coordinated transmission of the formatted data to *one of the remote locations*." *Id.* Dependant Claim 34 disclosed "a transmission system as recited in claim [33], wherein the plurality of libraries are geographically separated." *Id.* at 2.

After an initial rejection, on December 30, 1994, the examiner again rejected Claims 33 and 34. Hymas Decl., Ex. M at 1. The examiner explained that both claims were anticipated by Ballantyne, *et al.*'s patent disclosing a method and apparatus for distributing movies. *Id.* at 4-5. (The Ballantyne reference is dated August 28, 1990, before Acacia's earliest filing date. Hymas Decl., Ex. N.) In a May 30, 1995, response, the applicants responded to the rejection by arguing that Ballantyne failed to disclose:

> the claimed identification encoding means for retrieving information in items from a plurality of library means and transmitter means for transmission of formatted data from a plurality of libraries *to one of a plurality of remote locations*.
>
> Ballantyne et al. further fail to even remotely suggest collecting information from a plurality of geographically separated libraries for transmission to *a single remote location* as recited in claim 34.

Hymas Decl., Ex. O at 5 (emphasis added). Thus, the applicants argued that Ballantyne did not anticipate because it did not disclose transmissions to a "single remote location" among the plurality of remote locations. Claim 1 of the issued '863 patent contains the same "one of the remote locations" language that was in prosecution Claim 33 and, by extension, in dependent Claim 34.[7] Hymas Decl., Ex. K at 19:52.

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[7] While prosecution Claims 33 and 34 were never issued, Claim 1 of the '863 patent includes the same phrase "one of the remote locations." Hymas Decl., Ex. K at 19:52.

The ‘863 prosecution history confirms the Satellite Defendants’ proposed construction. Both Claim 1 of the ‘863 patent and Claim 41 of the ‘992 patent include the general reference to “remote locations” in their preambles.[8] This general reference is modified by the phrase “one of the remote locations” in the final claim limitation. When pressed during prosecution on the meaning of the phrase “one of the remote locations” in light of relevant prior art, the patentees’ explanation reinforces the conclusion that the phrase refers to one *and only one* location. The meaning of the statements “one of a plurality” and “a single remote location” is plain: the patentees limited the phrase “one of the remote locations” to one and only one remote location.

When patents “all derive from the same parent application and share many common terms, [courts] must interpret the claims consistently across all asserted patents.” *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005); *see also Epcon Gas Sys., Inc., v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1031 (Fed. Cir. 2002). Moreover, a later-filed patent’s prosecution history may be relevant to a prior-filed patent’s claim terms when the two patents share the same specification. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1349-50 (Fed. Cir. 2004). In *Microsoft*, the court rejected the patentee’s argument that subsequent prosecution history statements should not apply to prior patents, explaining that “[a]ny statement of the patentee in the prosecution of a related application as to the scope of the invention would be relevant to claim construction.” *Id*. at 1350. Moreover, there, as here, “the relevance of the statement [was] enhanced by the fact that it was made in an official proceeding in which the patentee had every incentive to exercise care in characterizing the scope of its invention.” *Id*.

In its 2004 *Markman* order, the Court interpreted *Microsoft* to prevent application of a subsequent Yurt patent’s prosecution history to the ‘992 patent’s terms where: (1) the patentees’ comments were directed toward claim amendments, as opposed to interpreting the specification, and (2) the prior art leading to the comments post-dated the ‘992 priority date. *Markman I* at 7.

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[8] Claim 10 of the ‘863 patent confirms that the patentee used the appropriate plural language when it claimed transmitting to *more than one* remote location. In sharp contrast to Claim 41 of the ‘992 patent, Claim 10 of the ‘863 patent recites transmitting “to *at least one* of a plurality of the remote locations.” Hymas Decl., Ex. K at 21:16-17.

Here, neither condition is present. As in *Microsoft*, the patentees' comments relate to the scope of the invention, as they viewed the invention in light of prior art, and not to any amendments in response to that prior art. *See Microsoft*, 357 F.3d at 1349 & n.5. In addition, the Ballantyne priority date, August 28, 1990, *pre*-dates the January 7, 1991, priority date of the '992 patent. Consideration of the '863's prosecution history is, therefore, both appropriate and consistent with the *Microsoft* decision.

The patentees' use of the phrase "one of the remote locations" in the '863 patent is consistent with their use of the phrase in the '992 patent. The patentees' explanation is also consistent with the common and ordinary meaning of the term "one." Like *Microsoft*, the Court should "take the patentee[s] at [their] word" and should not construe Claim 41 "more broadly than the patentee[s] clearly envisioned." *Id*. at 1350.

IV. THE TERM "'ITEMS' HAVING [OR CONTAINING] INFORMATION" SHOULD BE CONSTRUED TO MEAN "PHYSICAL OBJECTS ON WHICH INFORMATION IS STORED."

In its *Markman I* Order, the Court construed the phrase "items containing information" to mean "items containing information in analog or digital form." The Satellite Defendants do not take issue with that construction, so far as it goes. But it has become apparent that there is an unanticipated ambiguity in that construction: the meaning of "item" as it is used in this phrase, which the Court did not construe.[9]

The Satellite Defendants propose that the term "items" having or containing information be construed to mean "physical objects on which information is stored, such as videotapes and laser disks." Acacia relies on a general dictionary and proposes that an item containing information is a "thing" containing information. But such a construction is so broad as to be meaningless.[10] Dictionary definitions of common words should not be used in place of the patent

[9] The Satellite Defendants have no objection, however, if the Court defers consideration of this term to the August 11, 2006 *Markman* hearing so that it may be heard in conjunction with issues raised by the Round 3 Defendants, who have indicated that they will seek a reconsideration of the phrase "items containing (or having) information."

[10] Acacia argues that "[t]he term 'item' is an example of a term in which the ordinary meaning, as understood by persons of ordinary skill in the art, should be readily apparent." Acacia's April 17, 2006, *Markman* Brief at 16. This argument is curious because Acacia, during

(Footnote continues on next page.)

itself in defining claim terms. *See Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999). The Court cannot look at the meaning of a term in a vacuum; it must construe terms in the context of the intrinsic record. *See Phillips*, 415 F.3d at 1314. Here, the context dictates that "items having [or containing] information" should be defined as "physical objects on which information is stored."

The '992 patent specification uses the term "item" in multiple ways, sometimes referring to physical objects, and sometimes referring to information. But here, where the claims are specifically describing items *that contain information*, the only logical conclusion is that the items are physical ones.

A. The Context of Claim 41 Requires Defendants' Construction of "Items Having [or Containing] Information."

In the context of Claim 41, "items having information" are stored "*in a source material library*." Thus, we turn to the relevant portion of the specification that defines "items" in that context:

> Transmission system … of the present invention … includes source material library means for temporary storage of ***items*** prior to conversion and storage in a compressed data library….
>
> As shown in FIG. 2a, the source material library means included in transmission system 100 preferably includes a source material library 111. The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects. These materials are converted to or recorded on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in a compressed data library 118. The different media formats preferably include digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks and, [*sic*] cartridges.

'992 patent, 5:66-6:22.

(Footnote continued from previous page.)

Markman I, proposed that "item" should mean "units or members of a group or groups which have information." Hymas Decl., Ex. P at 23. Thus, even Acacia concedes that there is no ordinary meaning of this term in the context of the Yurt patents.

The above quote teaches one skilled in the art that the source material library includes "different types of materials," each of which is a physical object: "television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects." Indeed, by specifying "other physical objects" at the end of this list, the patent makes it clear that all of the members of the list are physical objects. These items are then converted to or recorded on a media format that is compatible with the inputs of the transmission system, before the converted or recorded material is compressed and stored in a compressed data library. *Id.* Therefore, in the context of Claim 41, "items" in the source material library means "physical objects on which information is stored, such as videotapes or laser disks."

B. Acacia's Proposal to Define "Items" Having or Containing Information as a "Thing" is Unavailing.

Acacia's argument is essentially this: because the specification describes some items in the source material library that are not physical objects, "items" should not be limited to physical objects. Rather, "items" must be defined as "things." The claims and the specification, however, do not support Acacia's argument.

Acacia first contends that the specification states that "items" may be "analog and digital audio and video information." Acacia's April 17, 2006, *Markman* Brief at 19. But the portion of the specification Acacia relies on actually says "items *of* information may include analog and digital audio and video information." '992 patent, 6:2-3 (emphasis added). There is a difference between "items *of* information" and "items containing [or having] information." The former self-defines items as information; the latter must be different from the "information" in order to contain items.[11]

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[11] Acacia's argument is also contrary to the specification, which makes clear that the "source material library" is a place that can "include different types of materials," ranging from books, to musical instruments, to video tapes. It is not a computer file server, which can only store digital information. It is a library, in the everyday sense of a physical place where media and other physical objects of many different types — not disembodied "information" — are kept.

Further, Acacia's proposal that an "item" can be *analog and digital audio and video information* would lead to a nonsensical result. As noted above, the Court has already construed the phrase "items containing information" to mean "items containing *information in analog or digital form*," which Acacia has not challenged. Thus, taking Acacia's assertion at face value, and combining it with the Court's prior construction, Acacia wants the phrase "items containing information" to be capable of meaning "analog and digital audio and visual information containing information in analog or digital form." This definition is completely recursive and makes no sense: information does not contain information.

The plain language of Claim 41 requires "information" to be contained in the "items." The first step of the claim reads: "*storing items having information* in a source material library." Therefore, Acacia's argument that "items" can be "information" must be rejected. As to Claim 41, "information" and "items" cannot have the same meaning.

Acacia next argues that "items" may be "files." Acacia's April 17, 2006, *Markman* Brief at 19. Here, Acacia appears to be arguing that an "item" can be a computer file. But the portion of the specification on which Acacia relies is clearly not referring to computer files, but files as "physical objects," *i.e.*, folders that contain papers. The specification states that the source material library may include "files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and *other physical objects*." '992 patent, 6:13-15 (emphasis added). Thus, "files," in this context, refers to *physical* files. This construction is confirmed by the fact that the specification states that these "files" must be "converted to or recorded on a media compatible to the digital and analog inputs of the system . . ." *Id*. at 6:15-19. The "file" in this context is clearly not a computer (*i.e.*, digital) file, or it would not have to be converted into digital information.[12]

[12] Claim 41 distinguishes between an "item having information" and a "file." It describes a method for: (a) retrieving information from an "item having information," (b) processing the information into compressed, formatted, and sequenced data blocks, and (c) storing those data blocks as a "file." Acacia's attempt to equate "items having information" with "files" is contrary to the rule that different words used in the same claim have different meanings, as well as the entire point of Claim 41 — generating a "file" from an "item having information in a source material library."

Finally, Acacia argues that because Claim 25 supposedly refers to an "item" as a "compressed formatted data block," it would be inconsistent to construe the term "item" to mean a physical object. Acacia's April 17, 2006, *Markman* Brief at 19-20. But Claim 25 refers to the converted "information" as the compressed formatted data block — not the "item." In relevant part, Claim 25 provides for a system including "an item stored in a source material library at a transmission system . . ., the item containing *information to be sent from the transmission system.*" '992 patent, 23:13-19 (emphasis added). The claim includes a "transceiver means . . . for receiving the item from the transmission system ***as*** at least one compressed, formatted data block." *Id.* at 23:23-25 (emphasis added). Thus, the natural reading of Claim 25 is that the "information to be sent," extracted from the "item," is converted into compressed, formatted data blocks, and in this form, sent *as* the "item."

Acacia's interpretation of Claim 25 equating "items" with compressed data blocks is also inconsistent with the disclosure in the specification, which repeatedly states that "compressed formatted data blocks" are stored in the "compressed data library," not the "source material library." *See, e.g., id.* at 6:8-47; 10:31-45. If the claim drafter intended to mean that the "item" itself was to be compressed, Claim 25 would not have introduced the "information" that is contained in the "item," and the claim would have read, "transceiver means . . . for receiving the compressed, formatted item from the transmission system." Therefore, the use of the term "item" in Claim 25 is consistent with the Satellite Defendants' proposed construction that "items" should mean "physical objects on which information is stored, such as a videotapes and laser disks."

Apart from the intrinsic support that the "items" are physical objects, Acacia's own statements confirm that "items" are physical objects. In its *Markman I* Opening Claim Construction Brief, Acacia acknowledged that "items" are media that contain information:

> In the context of the '992 patent, the information is in items, and the items are different media types which may be stored in the library means: "The different media formats preferably include digital or analog video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges." ('992 patent, 6:19-22).

Hymas Decl, Ex. P at 26. In the same brief Acacia also stated:

> As discussed above, the items containing information are described in the specification as having different media types which may be stored in the library means: "The different media formats preferably include digital or analog video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges." ('992 patent, 6:19-22).

Id. at 29.

For all of these reasons, the term "items" should be construed to mean "physical objects containing information, such as videotapes or laser disks."

V. THE TERM "ADDRESSABLE" REQUIRES THAT THERE BE A KNOWN ASSOCIATION BETWEEN A DATA BLOCK AND ITS STORAGE LOCATION.

The Satellite Defendants propose that the term "addressable," which modifies "data blocks" in Claim 41, means "that there is a known association between each data block and its storage location so that the transmission system can retrieve any individual data block by using its storage location."[13] Acacia proposes that it means "the ability to locate data blocks within an item anywhere in the system using relative time markers that have been assigned to the data blocks." Acacia's proposal, however, is flawed for the following reasons:

- Acacia's definition is overbroad because it only requires the "ability" to retrieve data blocks. Therefore, the definition covers systems that do not actually perform the claimed steps;
- Its definition is imprecise because it does not require that there be a known association to a storage location. Thus, it covers processes unrelated to addressability;
- Its definition provides addressability to be "anywhere in the system." This construction is unsupported by the specification; and

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[13] The Round 3 Defendants state that "sequence of addressable data blocks" is a term which has already been construed. The Satellite Defendants, however, are not requesting reconsideration of the Court's prior rulings. Rather, "addressable" is a new term that requires separate construction. Thus, it is appropriately considered now. The Satellite Defendants have no objection, however, if the Court defers consideration of this term to the August 11, 2006, hearing so that it may be heard in conjunction with issues raised by the Round 3 Defendants, who have indicated that they will seek a reconsideration of the phrase "sequence of addressable data blocks."

- Its definition provides "data blocks" to be within the "item." This is contrary to the plain language of Claim 41.

These issues are discussed separately below.

A. The Transmission System Must Have a Known Association to Retrieve the Data Blocks; Mere Ability is Not Enough.

Acacia proposes that the transmission system simply have the "ability" to retrieve data blocks. But such an unrestricted construction expands the definition to include processes that have nothing to do with retrieving data blocks from a storage location, but that *could* be modified to perform that function. This cannot be. A party can be liable only if he practices the steps of the patent claim. *See* 35 U.S.C. § 271(a) ("whoever without authority makes, uses, offers to sell, or sells any patented invention . . . infringes the patent.").

The language of Claim 41 provides that the transmission system actually retrieve the addressed data block from a storage location — not just have the "ability" to do so. Claim 41 requires that the transmission system processes formatted data to create a "sequence of addressable data blocks." The "storing" step provides that these "data blocks" are stored as a file. The phrase reads: "storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code." '992 patent, 25:1-3. Finally, the "sending" step requires that "at least a portion of the file" is sent to one of the remote locations: "sending at least a portion of the file to one of the remote locations." *Id*. at 25:4-5. Therefore, the transmission system of Claim 41 sends data blocks, *i.e.*, a portion of the file, to one of the remote locations. Before sending, the "data blocks" *must* necessarily be retrieved from the *stored* file.

Therefore, the transmission system of Claim 41 must have an architecture such that a data block *can* be retrieved from its storage location using a known association. Claim 41 does not cover a system that simply marks data blocks, with no architecture in place for retrieving the data blocks, even if such an architecture *may* be implemented.

B. "Addressable" Means that There is a Known Association Between a Data Block and its Storage Location.

Acacia proposes that "addressable" means only to "locate." But this is inadequate. To be "addressable" there must be a known association to a storage location to retrieve the data blocks. By omitting this critical limitation, Acacia's definition unduly expands patent protection beyond what should be afforded by the '992 patent. Such an unrestricted definition may cover common processes for managing data such as filtering, sorting, scanning, or searching. Yet, no one skilled in the art would call these processes "addressing" or "addressable." The claim language, the written description, and relevant dictionaries all support the conclusion that to be "addressable," there must be a known association between the data block and its storage location.

The logic of Claim 41 shows that the "addressable" data blocks must be addressed *by their storage location*. As discussed above, Claim 41 describes a method of: (a) processing information into a sequence of addressable data blocks; (b) compressing and storing the data blocks as a file; and (c) sending "at least a portion of the file." Therefore, the transmission system of Claim 41 must send data blocks, *i.e.*, a portion of the file. Before sending, the "data blocks" must first be retrieved from the *stored* file. Thus, addressability is necessary to retrieve data blocks from the stored file.

The specification uses "addressable" or "addressing" to mean a known association between an element and its storage location for the purpose of locating the element. For example, the specification describes "addressing" as an association between a song number and the starting frame number of the song so that it may be located from a storage location in the compressed data library. In this way, the song is "addressable":

> User and system *addressing requirements* dictate the level of granularity available to any particular section of the system…. For example, a user may desire to listen to a particular song. They may preferably enter the *song number* … when requesting the item from the compressed data library 118…. Internal to the system, the song is *associated* with a *starting frame number*, which was indexed by the system operator via the *storage encoding process*…. The frames are a subset of, and are contained within, *the items stored in the compressed data library* 118.

'992 patent, 8:32-50 (emphasis added).

The specification also provides that a file, stored in the compressed data storing means, is addressable through its unique identification code associated with the file for the purpose of locating that file:

> the transmission system 100 may further comprise compressed data storing means, coupled to the compression means, for *storing* as a *file* the compressed sequenced data with *the unique identification code* received from the data compression means…. The file is *addressable* through the unique identification code assigned to the data by the identification encoder.

Id. at 10:18-30 (emphasis added).

The specification further provides that stored items are addressable through their unique address code, frame number, and the library system address, associated with the items to locate the desired item:

> *Stored* items are preferably accessed in compressed data library 118 through a *unique address code*. The unique address code is a file address for uniquely identifying the compressed data items stored in the compressed data library section of a library system. This file address, combined with the *frame number*, and the *library system address* allow for complete *addressability* of all items stored in one or more compressed data libraries 118.

Id. at 10:46-57 (emphasis added).

Therefore, the specification demonstrates that the term "addressable" describes the ability to locate an element by employing a known association with a storage location so that the element sought can be located and retrieved.

Technical dictionaries also support this definition. IEEE defines "address" to mean "an identification, as represented by a name, label, or number, for a register, location in storage, or any other data source or destination such as the location of a station in a communication network," or "a character or group of characters that identifies a register, a particular part of storage, or some other data source or destination."[14] Hymas Decl, Ex. Q at 23. In a second reference, "address" is defined as "the term most generally used to refer (in some way) to a location within the computer memory; the word *location* is actually used as a synonym. Such reference is usually made for the purpose of retrieving or storing some information at that location." Hymas Decl., Ex. R at 7. The same reference also defines "addressable location" as, "[a] location whose position in a storage medium is precisely defined and can be accessed." *Id*. at 9. Therefore, the term "address," and consequently, "addressable" are storage properties, integrally coupled with a storage location.

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[14] Because the definition of "addressable" in Claim 41 modifies the term "data blocks," the dictionary's definition that "address" may mean an identification of a destination in a communication network does not apply in this case.

The claim, the specification, and relevant technical dictionaries support defining "addressable" to mean "that there is a known *association between each data block and its storage location* so that the transmission system can retrieve an individual data block by using its storage location."

C. Addressability Must be Within the Transmission System.

Acacia also proposes that "addressable" means "to locate data blocks . . . *anywhere in the system* . . . " This proposal is incorrect. The specification clearly provides that addressability of data blocks must be in the *transmission* system. For example,

> Time encoding by time encoder 114 makes itmes [sic] and subsets of items retrievable and *addressable* throughout the *transmission* system.

'992 patent, 8:50-52 (emphasis added). Other portions of the specification consistently describe locating elements in the compressed data library 118, which, as illustrated in Fig. 2a, is located in the transmission system. *See id*. at 8:32-52; 10:18-30; & 10:46-57. Indeed, this is the logical consequence of the steps of Claim 41 — the transmission system places the data blocks into addressable form, stores the addressable data blocks, then sends the data blocks to one of the remote locations. In view of the language of Claim 41 and the written description, the term "addressable" must refer to addressability within the *transmission system*.

D. The Data Blocks Cannot be "Within" the Items.

Equally unconvincing is Acacia's proposed definition that would require that the "data blocks" be "*within* an item." This proposal is inconsistent with the claim language. The language of Claim 41 defines the relationship between items and data blocks: "items" contain "information." The "information" retrieved from the "items" is identified, formatted, and placed into a “sequence of addressable data blocks.” The data blocks are then compressed and stored as a “file.” Therefore, “data blocks” are in the “*file*.” The “data blocks” are made up of information extracted *from an item*; they cannot be “*within* an item.”

For all of these reasons, Acacia’s definition should be rejected, and the Court should construe “addressable” to mean “that there is a known association between each data block and its storage location so that the transmission system can retrieve an individual data block by using its storage location.”

VI. CLAIM 45 IS INSOLUBLY AMBIGUOUS, AND THE CLAIM IS INDEFINITE.

A claim, read in light of the specification, must “reasonably apprise those skilled in the art both of the utilization and scope of the invention.” *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985). If the claim “is subject to construction, *i.e.*, it is not insolubly ambiguous, it is not invalid for indefiniteness.” *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004). Claim 45 of the ‘992 patent is not amenable to construction and is therefore indefinite.

Claim 45 depends from Claim 41. It discloses the additional step of “separately storing *a plurality of files*, each including compressed, sequenced data blocks.” The preamble of claim 45 makes clear that it specifically modifies the second storing step of Claim 41, *i.e.*, the seventh step of “storing, as a file, the compressed, formatted, and sequenced data blocks[.]” However, Claim 45 introduces an ambiguity regarding the *next* step of Claim 41, “sending at least a portion of *the file* to one of the remote locations.” This step, Step 8, refers specifically to sending “the file” to one of the remote locations. This reference to “the file” must have an antecedent basis in one of the preceding seven steps. Because Claim 45 introduces the additional limitation of “storing a plurality of files” into step 7 of Claim 41, the claim is rendered hopelessly ambiguous because it provides no clear indication of *which* of the “plurality of files” is being sent in step 8.

Acacia simply ignores the ambiguity introduced by Claim 45, stating in conclusory terms that because Claim 45 does not modify step 8 of Claim 41, “[i]t is obvious . . . that the file that was sent in Claim 41 is the same file that was sent in Claim 45."[15] Acacia's April 17, 2006, *Markman* Brief at 63. However, the reference to a plurality of files is fatal to a finding that it is definite. A simple example highlights the confusion Claim 45 introduces. If two individuals state that they are going to a friend's house and that they are going to eat dinner at "the house," the house at which they are going to eat is clear — the friend's house that they are visiting. If the same two individuals say that they are going to visit Tom's house, Bob's house, Sue's house, and John's house, and that they are going to then eat at "the house," it is ambiguous as to *which* house they are referring. In the same way, if a transmission system saves 100 files as part of Claim 41's step 7, it is hardly apparent which of the files is being sent in step 8. Claim 45 is therefore ambiguous and must be held indefinite.

CONCLUSION

For the reasons set forth above the Court should construe the claims are set forth above and should find that Claim 45 is indefinite.

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[15] Acacia's argument is nonsensical. Claim 45 *does not* refer to sending a file. Thus, it cannot be "obvious" that Claim 45 refers to "sending" the same file as Claim 41.